

REMARKS

Claims 1-72 are pending.

Independent claims 1, 25 and 49 have been amended to obviate a possible ambiguity by clarifying that, in addition to the cash or card, the discount means also is validated. Those claims also have been amended to clarify that the "discount means" is a tangible object that a user may provide to the automatic transaction machine.

New claims 71-72 have been added. Claim 71 recites that the discount means is inserted by a user into the automatic transaction machine; claim 72 recites that the discount means comprises a card or token.

Claims 1-70 were rejected as unpatentable over the Tedesco et al. patent.

The Law of Obviousness

A claimed invention is unpatentable due to obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art." 35 U.S.C. § 103(a).

Although a single prior art reference may, in appropriate circumstances, render a claim obvious, there must be showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the conclusion of obviousness. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (reversing conclusion of obviousness).

A single line in a reference may not be taken out of context and relied upon with the benefit of hindsight to show obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). Similarly, boilerplate statements in a prior art reference that other embodiments and the like can be used are generally insufficiently specific to support a finding of obviousness. See, e.g., *Fromsom v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1447 (Fed. Cir. 1997). Moreover, the mere fact that the prior art reference could be modified does not satisfy the requirements for a finding of obviousness. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). Instead, the suggestion or motivation to modify the prior art must be "clear and particular." See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*,

157 F.3d 1340, 1352, (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002).

As explained by the Court of Appeals for the Federal Circuit:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [] two statements of [the prior art reference] would have suggested to those of ordinary skill in the art, the two statements *cannot be viewed in the abstract*. Rather, they must be considered *in the context of the teaching of the entire reference*. Further, a rejection cannot be predicated on the mere identification in [the prior art reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

In re Kotzab, 217 F.3d at 1371 (emphasis added).

The requirement of a clear and particular suggestion or motivation prevents the use of improper hindsight based, for example, on the applicant's own disclosure as a blueprint for forming a faulty obviousness argument. *See, e.g., In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *Ecolochem, Inc. v. Southern California Edison Co.*, 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000). As explained by the Court of Appeals for the Federal Circuit:

Close adherence to [the required] methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'"

*In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999).

As discussed below, the required suggestion or motivation for modifying the cited reference to obtain the claimed subject matter is lacking.

The Pending Claims are Patentable over the Tedesco et al. Patent

The Tedesco et al. patent discloses a vending machine that can present a customer with a survey/questionnaire after the customer provides payment (*e.g.*, cash, cards, etc.) and selects an item to be vended. If the customer chooses to complete the survey/questionnaire, then the vending machine may reward the customer with a supplemental product, a discount on the customer's current purchase or subsequent purchase, or a cash rebate. In some cases, the machine determines whether the customer correctly answered questions on the questionnaire before providing the reward.

In contrast to pending claims 1, 25 and 49, the Tedesco et al. patent does not disclose or suggest validating any type of tangible discount means (such as a token or card) that the customer provides to the automatic transaction machine. Instead, according to the Tedesco et al. patent, the discount is based on the customer's completing the survey/questionnaire. The information provided by the customer to complete the survey/questionnaire of the Tedesco et al. patent is significantly different from and does not suggest the claimed "discount means."

In addition, there is absolutely no suggestion of the additional features of claims 71 and 72 reciting, respectively, that the discount means is inserted by a user into the automatic transaction machine and that the discount means comprises a card or token.

At least for those reasons, claims 1-62 and 71-72 should be allowed.

Furthermore, independent claim 63 (as well as dependent claim 2, for example) recites the use of a phantom coin signal to process the discount value. There is no suggestion of that feature in the Tedesco patent. Indeed, the Office action has not identified any signal in the Tedesco et al. patent that arguably could correspond to the claimed "phantom coin signal." Therefore, claim 63, as well as dependent claims 64-70, should be allowed as well.

Applicant : Craig Lewis et al.
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Enclosed is a check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Samuel Borodach
Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

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